

REMARKS/ARGUMENTS

In the Final Office Action mailed March 29, 2005, claims 1-7 were allowed and Claim 8 stand rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Final Office Action. All the pending claims at issue are believed to be patentable.

Claim 8 is presently amended. No claims are cancelled. No claims are added. As such, claims 1-8 remain pending.

CLAIM REJECTION – 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. § 251 as being based on new matter added to the patent for which reissue is sought. Specifically, the Final Office Action states that in claim 8, the limitations “disengageable with said...bottom shaft piece” in lines 8-9 and “disengaged from said...said bottom shaft piece” in lines 10-11 have no basis in the original disclosure. The Final Office action explains that the rationale behind the rejection is that “even when the top shaft cutting piece 201 is in the position shown in FIG. 3, it is still attached to the bottom shaft piece 202 by attachment means such as link 223 and is therefore not disengaged from it.”

Applicants respectfully disagree with Examiner's interpretation of claim 8. It appears that Examiner is interpreting the bottom shaft piece element to include the link 223. As shown in FIGS. 3 and 4A-D, the link 223 is a separate and distinct element from bottom shaft piece 202. It is a “link” because it serves as a separate linkage element between two pieces, one of which is the top shaft piece, the other being the bottom shaft piece. Yet, to recognize Examiner's concern in the Final Office Action, and to make the claim more clear, Applicants have herein amended claim 8 to recite that “said top shaft cutting piece is disengageable from said bottom shaft piece

such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur.” Thus, the top shaft piece 201 can be disengaged *in a particular manner* from the bottom shaft piece 202, as stated and described in the claim. When disengaged, the top shaft piece no longer touches the bottom shaft piece, but still remains attached to the rongeur overall, via a link, such as, in one preferred embodiment, link element 223. Thus, Claim 8, as amended, claims that the shaft pieces are disengageable from each other, not that the top shaft piece is disengageable from the rongeur overall. As clearly stated in amended Claim 8, the top shaft piece “remains linked to said rongeur.”

Applicants also point out that the present amendment to Claim 8 is not improperly broadening the scope of the claim because the present scope is essentially the same as the claim was presented prior to the Final Office Action, namely, that the “top shaft cutting piece remains attached to said rongeur so as to retain all parts of said rongeur in one attached unit.” Applicants have merely reworded the claim to remove ambiguities and make the claim clearer and more definite, in line with Examiner’s suggestions as discussed below.

Applicants therefore respectfully assert that no new matter has been added to the patent for which reissue is sought, as all elements recited in claim 8, as amended, are properly disclosed in the original patent.

CLAIM REJECTION – 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 8 has been amended to more clearly define what Applicant regards as the invention. Based on the reasons set forth above, Applicants believe that claim 8, which recites a “top shaft cutting piece [which] is disengageable from said bottom shaft

piece such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur” has adequate basis and is sufficiently described in the patent, as shown in FIGS. 3 and 4D.

CLAIM REJECTION – 35 U.S.C. § 112

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 8, the Final Office Action states that inclusion of the limitation “tip portion and said bottom shaft piece” in line 9 of claim 8 is unclear and makes no sense. As explained above, Applicants have eliminated said limitation to make the claim more clear and meet the Examiner’s suggestion. Accordingly, Applicants believe the claim is definite.

In view of the foregoing arguments, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, ¶ 1, as to claims 1-26, be removed.

CLAIM REJECTION – 35 U.S.C. § 102(a) or § 103(a)

Claim 8 is rejected under 35 U.S.C. § 102(a) as being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Applicant’s disclosure. The Final Office Action stated that FIG. 1A, being admitted prior art, showed the top shaft cutting piece as being disengaged from the tip portion of the bottom shaft piece. Applicants assert that the rejection is no longer necessary because of the present form of amended claim 8, which simply recites that the top shaft piece is disengageable from the entirety of the bottom shaft piece, “such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to said rongeur.” Such a configuration is not disclosed in the prior art FIGS. 1A-D disclosed in the patent.

Accordingly, Applicant respectfully submits that claim 8 is allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21501.

Respectfully submitted,

BAKER & HOSTETLER LLP



Erdal R. Dervis
Reg. No. 51,612

Date: June 28, 2005
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1744
Facsimile: 202-861-1783